

REMARKS

The withdrawal of the rejection under 37 CFR 251 is noted with appreciation.

The final rejection of claims 90-106 in this reissue application is respectfully traversed. This rejection is based upon the issue of “recapture” in the claims, wherein the Examiner’s position is that the scope of the claims now in the application are broader in an area in which they were narrowed by the applicant in order to gain allowance of the issued patent. The Examiner is again respectfully urged to reconsider this rejection in the light of In re Clement, because the present claims have been narrowed in a material aspect. That is, the additive package portion of the claimed composition that produces the benefits of the invention is now claimed more narrowly than was claimed in the issued patent.

The composition suitable for use as a hydraulic fluid set forth in the claims now pending can be divided between that component which was known in the art “normal alkyl phosphates” and the novel segment, “the additive package”. From this it is plainly seen that the narrowing of the claims from the issued patent was the most material change from the claims of the issued patent. The error that occurred in the issued patent was the failure to appreciate the invention in terms of a “good”, “better” and “best” hydraulic fluid. That is, the prior art phosphate ester based hydraulic fluids were “good” and have been in use in commercial aircrafts for years. What is claimed in the issued patent is the “best” hydraulic fluid, *i.e.* a clearly patentable advance in the art providing improvements that could not be expected by implementing the novel aspects of the issued claims. The error now seen is the failure to appreciate the evidence that was in the specification showing the “better” properties of prior art phosphate based fluids by the use of the novel additive package, which is now more narrowly claimed. Because the reissue statute

clearly provides for recovering subject matter that rendered the claim less than the applicant had a right to claim, it would appear that the ‘recapture’ rule would nullify the reissue statute.

By not allowing the present claims the Examiner’s action frustrates the purpose of the reissue statute. In this case, the applicant has both claimed less that he had right to claim and also more than he had a right to claim. Any “error” to claim less that the applicant had a right to claim must be addressed by some broadening in a reissue application. Having broadened the claims to correct one error and narrowing the claims to correct a more important error, it is respectfully pointed out that the portion narrowed is the point of novelty in the claims. Therefore, the narrowing of the claims is highly material, whereas the broadening occurs in that portion of the claim relating to prior art fluids.

The error now sought to be corrected was not in narrowing the claims, but rather in failure to notice and appreciate the data contained in the application which shows the “better” level of performance of prior art phosphate fluids with the novel additive package. The applicant had every right to claim this clearly patentable aspect of the invention and in doing so did not make any statement indicating that the prior scope was not patentable. Had the attorney providing the amended claims realized the “better” level of improvement shown by the data in the application, there would have been no reason to narrow the claims. In fact, as stated by Judge Rich in *In re Richman* 161 USPQ 359 “...while he acted deliberately, he did so in error; error can only be regarded as “error without any deceptive intention” within terms of 35 U.S.C. 251.”

Also in *Richman*, at p. 363 Judge Rich states:

“We therefore find neither decision to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly one might err without deceptive

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intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.”

In view of the above the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 90-106 based upon 35 U.S.C. 251.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner’s amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant’s undersigned attorney in this regard.

Respectfully submitted,

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